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Attorney's Docket No.: 07844-746001 / M143

REMARKS

By this paper, Applicant amends claims 1, 10, 23, 30, 32, 45, and 54. Claims 1, 23, and 45 are independent claims. No new matter has been added. Accordingly, claims 1-13, 15-35, 37-57, and 59-66 are pending and a listing of the pending claims has been provided. Reconsideration and further examination of this application are respectfully requested.

Rejections Under 35 U.S.C. § 103(a)

Claims 1-13, 15-17, 21-35, 37-39, 43-57, 59-61, and 65-66 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Applicant's Admitted Prior Art (hereinafter "AAPA", Specification pages 1-3) in view of U.S. Patent No. 6,762,777 issued to Carroll (hereinafter "Carroll"). This contention is respectfully traversed.

A *prima facie* case of obviousness for the rejected claims has not been established. First, Carroll is non-analogous art because it does not pertain to the same field of endeavor as the present application. This leads the Office to mistakenly equate Carroll's teaching that "the editable region is located above the selected object and commands being operated thereon" (p3, line 14 of Office Action mailed on 6/14/2006) with the elements recited in claim 1.

Claim 1 recites in relevant parts: "A method of editing a set of information comprising a plurality of objects, the method comprising: receiving a first set of at least one command in a graphical editor. identifying an initial text responsive to the set of information and the indication of the at least one command; and displaying, responsive to the initial text identified, at a location on a display screen, a text-based editor for a portion of the information, the portion and the location responsive to at least the first set of at least one command." (Emphases added).

Carroll teaches user-enabled popup windows associated with an electronic document rather than a "graphical editor" as recited in claim 1. For example, Carroll recites that "[t]he invention ... relates to a system and method for associating popup windows with selected regions of a document" (emphasis added; col. 1, lines 36-38) and "[i]n a preferred embodiment, the selected text is highlighted and, with a series of keystrokes or menu or icon selections, a popup window is associated with the selected text" (emphasis added; col. 2, lines 31-33). In contrast, claim 1 of the present application recites "receiving a first set of at least one command in a

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graphical editor" (emphasis added). Therefore, Carroll is non-analogous art because the present application "allows an author to command the system and method to display a text editor in a window near one or more objects selected using a graphics editor" (emphasis added; p. 5, lines 2-4 of the application as filed).

Even if Carroll can be treated as analogous art, there is no suggestion or motivation in the cited references for the proposed combination. In fact, combining the cited references is an improper hindsight reconstruction because the only motivation for the combination is applicant's own disclosure. (See, e.g., p4, lines 18-22 of the application as filed, stating "[w]hat is needed is a method and system that can allow information to be edited both graphically and textually, provides a more intuitive approach than other methods, can help prevent errors in the code, and can assist an author with selecting proper code"). Referring to claim 1, the Office states that "AAPA does not teach: the step of identifying an initial text responsive to the set of information and the indication of the at least one command, the step of displaying to be responsive to the initial text identified, and the location responsive to at least the first set of at least one command. ... It would have been obvious to an artisan at the time of the invention to combine Carroll's teaching with AAPA's method in order to let users easily and intuitively see what is being edited in proximity of the editing object based on associated commands." (P3, lines 7-19 of Office Action mailed on 6/14/2006). This is improper hindsight reconstruction, using one of the potential advantages of the claimed subject matter as a motivation to combine art that does not itself teach or suggest this potential advantage of the proposed combination. As discussed above, Carroll does not teach a text-based editor associated with a graphical editor and neither Carroll nor AAPA suggests a desirability to modify or combine the cited references as suggested by the Office.

Furthermore, even if the references could be properly combined, the combination simply does not teach or suggest all the elements of claim 1. For example, claim 1 recites "identifying an initial text responsive to the set of information and the indication of the at least one command; and displaying, responsive to the initial text identified" (emphases added). The Office states: "It is noted that in Carroll's method, the user is required to designate (identify) a region containing the initial text (fig. 1, col. 2, lines 31 et seq.; selected text "The Quick Brown Fox Jumped Over")" (p3, lines 14-16 of Office Action mailed on 6/14/2006). Contrary to this assertion, Carroll

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does not teach "identifying an initial text responsive to the set of information and the indication of the at least one command" recited in claim 1 because in Carroll, the user selects texts in a document and does not select objects in a graphical editor.

Therefore, Carroll's user-defined "selected text" is not responsive to both "the set of information" contained in the graphical editor and "the indication of the at least one command." For example, the Applicant disclosed that "[i]f the mode is 'edit tag', initial text/label selector 264 checks to see if the list of objects in the selection block contains one or more objects corresponding to code having single tag. If so, the initial text/label selector 264 identifies initial text by building the source code for the object or objects in the selection block, including that tag, including any attributes." (Emphasis added; p. 27, lines 11-17 of the application as filed). The Office mistakenly equates Carroll's method of allowing the user "[i]n the electronic text ...[to highlight] a region of the text as highlighted region" (col. 2, lines 34-36) to that of "identifying an initial text responsive to the set of information and the indication of the at least one command" as recited in claim 1. Therefore, the AAPA-Carroll combination does not result in the subject matter of claim 1, and claim 1 should be in condition for allowance.

Claims 23 and 45 include features similar to independent claim 1, and are thus patentable for similar reasons. Claims 2-3, 5-9, 11-13, 15-17, 21-22, 24-35, 37-39, 43-44, 46-57, 59-61, and 65-66 depend generally from claims 1, 23, or 45. Thus, these dependent claims are allowable for at least the reasons provided above.

Claims 18-20, 40-42, and 62-64 stand rejected under 35 U.S.C. §103(a) as being unpatentable over AAPA and Carroll in view of U.S. Patent No. 6,005,973 issued to Seybold et al. (hereinafter "Seybold"). Seybold does not cure the deficiencies of Carroll and AAPA. Thus, a *prima facie* case of obviousness has not been established for the rejected claims. Since claims 18-20, 40-42, and 62-64 depend from claims 1, 23, or 45, claims 18-20, 40-42, and 62-64 are allowable for at least the reasons provided above.

Additionally, claim 4 is a dependent claim which depends from claim 1 and recites "wherein the first set of at least one command comprises a selection of at least one of the plurality of objects." The suggested AAPA-Carroll combination also does not teach or suggest the additional element recited in claim 4 because Carroll merely teaches a method of allowing for user-selected text in a document and does not teach "selection" of objects in a "graphical

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editor". (See, e.g., p. 21, lines 8-11 of the application as filed stating that "[o]ne such command is a command requesting a pop up text editor window corresponding to a selection made, or an insertion point specified, in the graphics window") Thus, claim 4 should be allowable for at least this additional reason.

Furthermore, referring to claim 20 which recites "the plurality of possible words comprises at least one value of an attribute; ...". Seybold does not teach or suggest the recited element of claim 20. The Office mistakenly equates "attribute" and "value" (which are terms of art used in source code for web pages; see, also, p. 11, lines 11-15 of the application as filed stating "[f]or example, to set the background color of a web page, the bgcolor attribute may be specified in the body tag with a value set to a code for the color in between double quotes.") with that of possible candidate words from a dictionary as taught by Seybold (see, e.g., col. 3, lines 9-15 stating that "the process identifies (202) one or more candidate words by comparing the contents of a dictionary against various combinations of the candidate characters, and providing these various dictionary entries with a corresponding likelihood of being correct. The entries having the highest likelihood are then identified as candidate words."). Therefore, the suggested AAPA-Carroll-Seybold combination also does not teach or suggest the additional element recited in claim 20. Thus, claim 20 should be allowable for at least this additional reason.

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Conclusion

The foregoing comments made with respect to the positions taken in the Final Office Action are not to be construed as acquiescence with other positions taken in the Final Office Action that have not been explicitly contested. Accordingly, the above arguments for patentability of a claim should not be construed as implying that there are not other valid reasons for patentability of that claim or other claims.

A formal Notice of Allowance is respectfully requested. Please apply any necessary charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: _____

9/14/06



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